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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,424	06/24/2003	Gregory L. Bluem	51720US020	9617
32692	7590	02/06/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,424

Applicant(s)

BLUEM ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14 and 10/16/03</u> . | 6) <input type="checkbox"/> Other: ____ |

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to an adhesive comprising an alkyl acrylate, optionally a comonomer, and a core-shell polymer or semi-crystalline polymer, classified in class 525, subclass 308.
 - II. Claims 13-20, drawn to an adhesive comprising an alkyl acrylate, optionally a comonomer, and a chain transfer agent, classified in class 526, subclass 328.
2. The inventions are distinct from each other because the core-shell polymer or semi-crystalline polymer of Invention I is a materially different material from the chain transfer agent of Invention II.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention:
 - (b) The presence or absence of the comonomer, wherein if its presence is elected, a particular species is identified such as the isobornyl acrylate disclosed on page 6, line 16 and exemplified in Example 1, page 27, line 14.
 - (d) The presence or absence of the electrically conductive material of claim 9 and 10, or claim 16 and 17, wherein if its presence is elected, a particular species is identified such as the nickel spheres of Example 14 on page 31, line 9.

(e) The presence or absence of the thermally conductive material of claim 11 or 18, wherein if its presence is elected, a particular species is identified although the specification does not reveal any species (page 15, line 20).

Contingent upon the election of Invention I:

Items (b), (d) and (e) hereinabove and

(c) a core-shell polymers or semi-crystalline polymers wherein a particular species thereof is identified, such as the methacrylate/butadiene/styrene core-shell polymer of Examples 25-26 on page 36, line 4 of the specification.

Contingent upon the election of Invention II:

Items (b), (d) and (e) hereinabove and

(c) The chain transfer agents such as either carbon tetrabromide (CBr₄), iso-octyl thioglycolate (IOTG) or n-dodecylmercaptan (NDDM) shown on page 30, lines 13-15 and page 31, Table 1.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species within each of items (b), (d), (e) and (c) hereinabove for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-20 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. The status of parent application no. 09/765,233 as abandoned should be inserted into page 1, line 8 in place of the phrase "now pending."

(571) 272-1093 (Fax no. (703) 872-9306)
Monday to Friday from 9:30 to 6:00 EST

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Robert Sellers
Primary Examiner
Art Unit 1712